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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/725,198	12/01/2003	Paul Y. Moreton	02-40068-US-CON (932702.2)	9830
7590 05/19/2006			EXAMINER	
REED SMITH LLP 2500 One Liberty Place 1650 Market Street Philadelphia, PA 19103-7301			TOMASZEWSKI, MICHAEL	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/725,198

Applicant(s)

MORETON ET AL.

Examiner

Mike Tomaszewski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Notice To Applicant

1. This communication is in response to the application filed on 12/1/2003. Claims 1-21 have been cancelled. Claims 22-41 are pending.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 22-23, 25-26, 29-30, 35, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne et al. (5,867,821; hereinafter Ballantyne), in view of Evans (5,924,074; hereinafter Evans).

- (A) As per claim 1, Ballantyne discloses a personal assistant system, comprising:

- (1) a personal assistant (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B);

- (2) an electronic physician data module for collecting, storing, processing, and referencing information, the electronic physician data module being in said personal assistant (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B);
- (3) a sound recording device integral with said personal assistant (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B); and
- (4) a dictation module for electronically storing recorded voice from said sound recording device as a voice file, the automated dictation module being adapted to associate said voice file with said information (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

Ballantyne, however, fails to expressly disclose a personal assistant system, comprising:

- (5) an automated data collection module for inputting a patient identifier and relating said identifier with said information, the automated data collection module being in said personal assistant.

Nevertheless, this feature is old and well known in the art, as evidenced by Evans. In particular, Evans discloses a personal assistant system, comprising:

- (5) an automated data collection module for inputting a patient identifier and relating said identifier with said information, the automated data collection module being in said personal assistant (Evans: abstract; col. 1, line 1-col. 3, line 43; Fig. 1-24).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Evans with the teachings of Ballantyne with the motivation of storing medical records in personal digital assistants (Evans: col. 1, lines 5-10).

- (B) As per claim 23, Ballantyne discloses the system of claim 22, further comprising an information transmission device integral with said personal assistant (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

- (C) As per claim 25, Ballantyne discloses the system of claim 23, wherein the information transmission device is a magnetic strip reader (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; col. 11, lines 40-47; Fig. 1-12B).

- (D) As per claim 26, Ballantyne discloses the system of claim 23, wherein the information transmission device is an infra-red beam (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

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(E) As per claim 29, Ballantyne discloses the system of claim 22, further comprising a connection to an external computer (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

(F) As per claim 30, Ballantyne discloses a method of automatically associating information with an individual identified by an identifier, said method comprising:

- (1) storing said information in a personal assistant (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B); and
- (2) recording a voice file associated with said information (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

Ballantyne, however, fails to expressly disclose a method of automatically associating information with an individual identified by an identifier, said method comprising:

- (3) reading an identifier and relating said identifier with said voice file; and
- (4) automatically associating the identifier with the information.

Nevertheless, this feature is old and well known in the art, as evidenced by Evans. In particular, Evans discloses a method of automatically associating information with an individual identified by an identifier, said method comprising:

- (3) reading an identifier and relating said identifier with said voice file (Evans: abstract; col. 1, line 1-col. 3, line 43; Fig. 1-24); and
- (4) automatically associating the identifier with the information (Evans: abstract; col. 1, line 1-col. 3, line 43; Fig. 1-24).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Evans with the teachings of Ballantyne with the motivation of storing medical records in personal digital assistants (Evans: col. 1, lines 5-10).

(G) As per claim 35, Ballantyne discloses the method of claim 30, further comprising the step of transferring the information to a computer (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

(H) Claims 38-39 substantially repeat the same limitations as those of claims 22-23 and therefore, are rejected for the same reasons given for that claim and incorporated herein.

(I) As per claim 40, Ballantyne discloses the software program of claim 38, wherein the electronic physician data module associates a patient record with a patient (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

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(J) As per claim 41, Ballantyne discloses the software program of claim 40, wherein said association occurs via data gathered by an information transmission device (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

4. Claims 24, 27-28, 31-34, and 36-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ballantyne, in view of Evans, as applied to claim 22 above, and further in view of Schultz et al. (5,679,943; hereinafter Schultz).

(A) As per claim 24, Ballantyne fails to expressly disclose the system of claim 23, wherein the information transmission device is a laser configured to read bar codes.

Nevertheless, these features are old and well known in the art, as evidenced by Schultz. In particular, Schultz discloses the system of claim 23, wherein the information transmission device is a laser configured to read bar codes (Schultz: abstract; col. 6, line 15, col. 8, line 2; Fig. 1-74).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Schultz with the combined teachings of Ballantyne and Evans with the motivation of providing an improved hand-held terminal (Schultz: col. 2, lines 60-63).

(B) As per claim 27, Ballantyne fails to expressly disclose the system of claim 23, wherein the information transmission device is an alpha-numeric scanner.

Nevertheless, these features are old and well known in the art, as evidenced by Schultz. In particular, Schultz discloses the system of claim 23, wherein the information transmission device is an alpha-numeric scanner (Schultz: abstract; col. 6, line 15, col. 8, line 2; Fig. 1-74).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Schultz with the combined teachings of Ballantyne and Evans with the motivation of providing an improved hand-held terminal (Schultz: col. 2, lines 60-63).

(D) As per claim 28, Ballantyne fails to expressly disclose the system of claim 23, wherein the information transmission device is a radio frequency transceiver.

Nevertheless, these features are old and well known in the art, as evidenced by Schultz. In particular, Schultz discloses the system of claim 23, wherein the information transmission device is a radio frequency transceiver (Schultz: abstract; col. 2, lines 40-60; col. 6, line 15, col. 8, line 2; Fig. 1-74).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Schultz with the combined teachings of Ballantyne and Evans with the motivation of providing an improved hand-held terminal (Schultz: col. 2, lines 60-63).

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(E) As per claim 31, Ballantyne discloses the method of claim 30, wherein the step of reading scans a code uniquely associated with the individual (Ballantyne: abstract; col. 1, line 1-col. 2, line 63; Fig. 1-12B).

Ballantyne, however, fails to expressly disclose the method of claim 30, wherein the step of reading scans a *bar* code [Emphasis added.].

Nevertheless, these features are old and well known in the art, as evidenced by Schultz. In particular, Schultz discloses the method of claim 30, wherein the step of reading scans a bar code (Schultz: abstract; col. 2, lines 40-60; col. 6, line 15, col. 8, line 2; Fig. 1-74).

One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Schultz with the combined teachings of Ballantyne and Evans with the motivation of providing an improved hand-held terminal (Schultz: col. 2, lines 60-63).

(F) Claims 32-34 substantially repeat the same limitations of claim 31 and therefore, are rejected for the same reasons given for that claim and incorporated herein.

Moreover, Examiner notes that Applicant's duplication of bar codes (e.g., a second bar code associated with the information; scanning the second bar code, associating the information associated with the second bar code, etc.) has no patentable significance unless a new and unexpected result is produced. *In re Harza*, 274 F. 2d 669, 124 USPQ 378 (CCPA 1960).

(G) Claim 36 substantially repeats the same limitations as those of claim 31 and therefore, is rejected for the same reasons given for that claim and incorporated herein.

(H) Claim 37 substantially repeats the same limitations as those of claim 24 and therefore, is rejected for the same reasons given for that claim and incorporated herein.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure. The cited but not applied art teaches a personalized hand held calorie counter (5,890,128); a micro-computer and printer for printing a prescription slip (5,884,273); a modular microprocessor-based health monitoring system (5,307,263).

The cited but not applied prior art also includes non-patent literature articles by Michael Menduno ("Power To The Pad" Sep 1999. Hospitals & Health Networks. Vol. 73, Iss. 9. pg. 28.); Jeff Barbian ("Lending A Helping Hand To Health Care" Jul 1999. Computer User. Vol. 18, Iss. 7. pg. 22.); and NY Times News Service ("Maternity Ward Fashions: Chip ID's And Bar Codes More Hospitals Use Technology To Make Sure Newborns Go Home With The Right Mother" Sep 20, 1999. Greensboro News Record. Pg. D.2.).

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Tomaszewski whose telephone number is (571)272-8117. The examiner can normally be reached on M-F 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on (571)272-6776. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MT



C. LUKE GILLIGAN
PATENT EXAMINER